

REMARKS

At the outset, Applicants wish to thank Examiner Lopez for the courtesies extended to Applicants' representative during their telephonic interview on November 6, 2007. The substance of the interview is incorporated in the following remarks.

Summary of the Office Action

In the Office Action, claims 1-3 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,009,355 to *Akizawa et al.*, hereinafter ("Akizawa").

Claims 4-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Akizawa* in view of U.S. Patent No. 5,836,502 to *Kanai, et al.*, hereinafter ("Kanai").

Summary of the Response to the Office Action

Applicants respectfully submit that the features of the present invention are not taught or suggested by the applied references of record. Accordingly, claims 1-5 are pending for further consideration, with claim 6 being withdrawn from consideration.

All Subject Matter Complies with 35 U.S.C. § 102(b)

Claims 1-3 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Akizawa*. Applicants respectfully traverse the rejection for the following reasons.

Applicants respectfully submit that the Office Action has not established that *Akizawa* anticipates each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Namely, Applicants contend that independent claim 1 recites the features of "a table, supported by a main body frame of the electric stapler, and including a clincher mechanism for folding to bend a leg portion of the staple penetrated through

the sheets along the sheets, and a wing piece formed at the table.” At least these features are not disclosed or taught by *Akizawa*.

Akizawa discloses an electric stapler. See the Abstract of *Akizawa*. The Office Action asserts that *Akizawa* shows “a table 4 supported by a main body frame 1 of the electric stapler, and including a clincher mechanism.” However, *Akizawa* actually teaches that “[a] magazine 3 and an actuating link 4 are pivotally mounted at their first ends 4a and 3a respectively on a support shaft’2 mounted on a base 1.” See Figs. 1 and 2 and col. 4, line 27-35 of *Akizawa*. In contrast to the assertions in the Office Action, *Akizawa* discloses an actuating link 4 that does not include a clincher member 38. See Figs. 1 and 6 and col. 8, lines 51-58 of *Akizawa*. According to claim 1, a clincher must be included within the table. The clincher is clearly missing from the alleged table 4 of *Akizawa*. In fact, it is the base 1 of *Akizawa* that includes the clincher member 38 and it is opposed to the driver 5a and so-called table 4. See Fig. 1 and col. 4, lines 28-48 of *Akizawa*. As such, *Akizawa* cannot anticipate the present invention.

Stated another way, the Office Action asserts that *Akizawa* shows “a table 4 supported by a main body frame 1 of the electric stapler, and including a clincher mechanism 5b.” See page 2 of the Office Action. However, *Akizawa* actually teaches that a clincher device B is located in the stapler base 1, and not in the alleged table 4. *Akizawa* discloses an actuating link 4 that does not include the clincher device B or the clincher member 38. See Figs. 2 and 6 and col. 8, line 51 through col. 9, line 25 of *Akizawa*.

Further, the alleged clincher mechanism 5b is actually a forming member 5b that folds individual straight staples into U-shaped staples before they are driven into the sheets below. A

driver 5a is located in the alleged table 4 with the alleged clincher mechanism 5b. See Figs. 1a and 1b of *Akizawa*. It would be impossible for a driver 5a to be located on the same side as the alleged clincher mechanism 5b because the two devices must be opposed to each other in order to operate. The driver 5a must be able to drive a U-shaped staple into the clincher mechanism in order to fold the legs of the U-shaped staple back against the paper sheets. As alleged, the Office Action's orientation of components of the stapler is erroneous.

According to claim 1 of the present invention, a clincher must be included within the table. The clincher device B of *Akizawa* is clearly missing from the alleged table 4 of *Akizawa*. Claim 1 recites "a table, supported by a main body frame of the electric stapler, and including a clincher mechanism for folding to bend a leg portion of the staple penetrated through the sheets along the sheets, and a wing piece formed at the table." Claim 1 makes clear that the table includes a clincher mechanism to bend the leg portions of the staple after the staple has penetrated the sheets. As such, the staple must be driven first. The alleged clinching by 5b referred to in the Office Action (is actually a forming step to form the staple into a U-shape) can only occur before the staple is driven. Thus, the forming member 5b cannot be the alleged clincher mechanism.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). The Office Action's allegations are unsupported and simply wrong. Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. §

102(b) should be withdrawn because *Akizawa* does not teach or suggest each feature of independent claim 1.

Additionally, Applicants respectfully submit that dependent claims 2-3 are also allowable insofar as they recite the patentable combinations of features recited in claim 1, as well as reciting additional features that further distinguish over the applied prior art.

All Subject Matter Complies with 35 U.S.C. § 103(a)

Claims 4-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Akizawa* in view of *Kanai*. Applicants respectfully traverse the rejection for the following reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met (see MPEP §§ 2142-2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations.

Claims 4 and 5 depend from independent claim 1 and are allowable because *Kanai* does not make up for the above-mentioned deficiencies of *Akizawa*. *Kanai* teaches a motor driven stapler. See the Abstract of *Kanai*. *Kanai* is only relied upon to provide an eccentric cam supported by the main body frame and engaging teeth.

Applicants respectfully submit the Office Action has not established a *prima facie* case of obviousness at least because neither *Kanai* nor *Akizawa*, whether alone or in combination, teaches or suggests all the recited features of claims 4 and 5. Namely, none of the references teaches or suggests at least the “a table, supported by a main body frame of the electric stapler,

and including a clincher mechanism for folding to bend a leg portion of the staple penetrated through the sheets along the sheets, and a wing piece formed at the table," features recited in independent claim 1 from which claims 4 and 5 depend. At least these features are absent from, and are neither disclosed nor taught, alone or in combination, by either *Akizawa* or *Kanai*.

As pointed out in M.P.E.P. § 2143.03, "[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art". *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). As such, Applicants respectfully assert that at least the third prong of *prima facie* obviousness has not been met. Therefore, Applicants respectfully request that the rejection of claims 4-5 under 35 U.S.C. § 103(a) should be withdrawn because *Akizawa* and *Kanai* do not teach or suggest each and every feature of independent claim 1.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the Response, the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

By:



David E. Connor
Reg. No. 59,868

Dated: November 13, 2007

CUSTOMER NO. 009629
MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
Tel: 202-739-3000
Fax: 202-739-3001